

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-11 and 13-19 remain active in this case, Claims 9, 11, 13 and 14 having been amended and Claims 12 and 20 canceled by the present amendment.

In the outstanding Office Action, Claims 1-3, 6-10 and 17-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Horimai (US Patent 7,002,891 B2) and further in view of Kuroda (US Patent 5,576,084). Claims 4, 5, 15 and 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Horimai and Kuroda and further in view of Tsukamoto (US Patent 7,042,824 B2). However, Claims 11-14 were objected to as being dependent upon a rejected base claim, but were otherwise indicated as including allowable subject matter if rewritten in independent form.

Applicants acknowledge with appreciation the indication of allowable subject matter. In light of this indication, and to advance prosecution, Claim 9 has been amended to include the allowable subject matter of Claim 12, and Claim 11 has been amended to be in independent form. As Claims 10 and 13 -19 depend from Claim 9, and in view of the present amendment placing allowable claims in independent form, Claims 9-11 and 13-19 are in condition for formal allowance.

Applicants respectfully traverse the outstanding grounds for rejection of Claims 1-8 because these claims are also believed to define allowable subject matter.

In particular, Applicants respectfully disagree with the finding stated at page 3, line 21 to page 4, line 3 in the outstanding Office Action that,

One of ordinary skill in the art at the time the invention was made would have been motivated to combine the teachings in order to "minimize cross-talks between neighboring tracks of a series of information pits and between neighboring information pits by providing the variable transmittance material layer" (Kuroda column 2 lines 19-23).

Information pits as employed in Kuroda are the recording marks of a read only memory such as CD-ROM . In a holographic recording medium as taught by Horimai, information is recorded by producing an optical characteristic distribution inside the recording layer by using interference, as noted in the Horimai abstract, for example, and as described on page 1, line 27 to page 2, line 7 of the specification. Since such an optical characteristic distribution clearly differs from the information pit, and since the cited Kuroda and Horimai references are directed to entirely different technologies with completely different recording and play back characteristics, it is respectfully submitted that minimizing cross-talks between neighboring tracks of a series of information pits and between neighboring information pits cannot motivate the artisan to combine the masking layer of Kuroda with the holographic recording medium of Horimai. If anything, the proposed modification in regard to the completely different operating principles would suggest a change in the principle of operation of Horimai, which cannot sustain a rejection under 35 USC 103,<sup>1</sup> and furthermore, there is absolutely no teaching in the art that would provide any reasonable expectation of success in regard to such a modification, which is another reason why the outstanding rejection is believed to be improper.<sup>2</sup> Therefore, withdrawal of the outstanding grounds for rejection of Claims 1-8 is believed to be in order and is respectfully requested.

Consequently, in view of the present amendment, and in light of the above comments, no further issues are believed to be outstanding, and the application as amended herewith is

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<sup>1</sup> See MPEP 2143.01 (VI).

<sup>2</sup> See MPEP 2143.02.

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Reply to Office Action of October 27, 2006

believed to be in condition for formal allowance. An early and favorable action to that effect  
is respectfully requested.

Respectfully submitted,

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